

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

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| In re Application of: | Brian J. Brown, Michael Davis, David Friesen, Timothy J. Ley and Sean Skubitz |
| Application No.: | 10/705273 |
| Filed: | November 10, 2003 |
| For: | Improved Longitudinally Flexible Expandable Stent |
| Examiner: | Vy Q. Bui |
| Group Art Unit: | 3773 |

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Docket No.: S63.2N-6769-US03

APPEAL BRIEF

This is an Appeal Brief for the above-identified application in which pending claims 38 – 39, 42 – 43, and 45 – 46 were rejected in a Final Office Action dated **May 30, 2008**.

A Notice of Appeal for this case is filed concurrently herewith. The fees required for filing the Notice of Appeal and this Appeal Brief under 37 C.F.R. § 1.17(b) are included herewith. The Commissioner is authorized to charge Deposit Account No. 22-0350 for any other fees which may be due with this Appeal.

(i) Real Party in Interest

The Application is assigned to Boston Scientific Scimed, Inc., formerly known as Scimed Life Systems, Inc., One SciMed Place, Maple Grove, Minnesota 55311-1566, a Minnesota corporation and a subsidiary of Boston Scientific Corporation, One Boston Scientific Place, Natick, Massachusetts 01760-1537, a Delaware Corporation.

(ii) Related Appeals and Interferences

None.

(iii) Status of the Claims

Claims 38 – 56 are pending in this application.

Claims 1 – 37 were canceled by preliminary amendment.

Claims 40, 41, 44, and 47 – 56 were withdrawn from consideration.

Claims 38 – 39, 42 – 43, and 45 – 46 were finally rejected and are the subject of this Appeal.

(iv) Status of Amendments

No amendments were filed after the final rejection.

(v) Summary of Claimed Subject Matter

A summary of representative independent claims, as required by 37 C.F.R. §41.37(c)(1)(v), and a non-limiting listing of locations where support may be found [bracketed citations] is provided as follows:

Claim 38 is directed toward a stent in the form of a thin-walled, cylindrical tube with a longitudinal axis [FIG. 3; page 14, lines 14 – 16]. The stent comprises a multiplicity of interior circumferential sets of strut members [FIGs. 2 – 3 ; page 8, lines 1 – 5; page 14, lines 3 – 11] and one end circumferential set of strut members at each of the two longitudinal ends of the stent [FIGs. 2 – 3; page 8, lines 15 – 16; page 14, lines 3 – 21]. Each interior circumferential set of strut members includes at least one connected strut member consisting of a long diagonal section having a longitudinal length fixedly attached to a connected curved section [FIGs. 2 – 3; page 14, lines 3 – 21]. Each connected curved section is joined by means of a longitudinal connecting link to one connected curved section of an adjacent circumferential set of strut members. [FIGs. 2 – 3; page 14, lines 3 – 21]. All connecting links that connect adjacent circumferential sets of strut members are connected at a connected curved section [FIGs. 2 – 3]. Each interior set of strut members also includes at least one unconnected strut member consisting of a short diagonal section having a longitudinal length fixedly joined to an unconnected curved section [FIGs. 2 – 3; page 14, lines 3 – 21].

(vi) Grounds of Rejection to be Reviewed on Appeal

I. Whether the Examiner erred in rejecting claims 38, 42 – 43, and 45 under 35 U.S.C. § 102(c) as being anticipated by U.S. Patent No. 6,190,403 to Fischell et al. (hereafter “Fischell”).

II. Whether the Examiner erred in rejecting claims 38 and 39 under 35 U.S.C. § 102(c) as being anticipated by U.S. Patent No. 5,810,872 to Kanesaka et al. (hereafter “Kanesaka”).

III. Whether the Examiner erred in rejecting claim 46 under 35 U.S.C. § 103(a) as being unpatentable over Fischell in view of U.S. Patent No. 5,800,526 to Anderson et al. (hereafter “Anderson”).

(vii) Arguments

I. Rejection Of Claims 38, 42 – 43, And 45 Under 35 U.S.C. § 102(E) By Fischell

Regarding Claim 38 and Those Claims Dependent Therefrom

Fischell fails to teach or suggest all the elements of claim 38. Claim 38 was presented in order to provoke an interference with U.S. Patent No. 6,540,775 (hereafter “the ‘775 patent”). Although not copied from the ‘775 patent, claim 38 substantially corresponds to at least claim 1 of the ‘775 patent.

The Examiner asserted in the Final Office Action that because “[t]he claims presented in this patent application are not word by word copied claims of U.S. Patent No. 6,540,775...the scope(s) of the claims of the present application and U.S. Patent No. 6,540,775 can not be the same.”

Applicants are unaware of any case law or MPEP section that supports the Examiner’s assertion. In fact, the MPEP explicitly encourages an Applicant to *not* present word-for-word copies of claims: “Rather than copy a claim literally, the better practice is to add (or amend to create) a fully supported claim and then explain why, despite any apparent differences, the claims define the same invention.” MPEP § 2304.02(d). Furthermore, the MPEP states that even if the claim *was* a word-for-word copy of another’s claims, the scope of the two claims could nevertheless be different:

Historically, an applicant provoked an interference by copying a claim from its opponent. The problem this practice created was that differences in the underlying disclosures might leave the claim allowable to one party, but not to the other; *or despite identical claim language differences in the disclosures might require that the claims be construed differently.* Id. (Emphasis added)

Therefore, it is the *underlying disclosures* that determine the scope of a copied claim, and *not* whether a claim is a word-for-word copy. One of ordinary skill will recognize that the claimed subject matter of the '775 patent is represented by copied claim 38, despite the fact that claim 38 is not a word-for-word copy of claim 1 of the '775 patent.

Applicants respectfully assert that because claim 38 substantially corresponds to at least one of the claims of the '775 patent and was presented in the instant application in order to provoke an interference, and because the '775 patent describes the claim terms, the Examiner must adopt the definitions, meanings, and/or usages of the terms in claim 38 *as those terms are used in the '775 patent*, as will be described below.

The Examiner attempted to equate the limitations of claim 38 with FIG. 9 of Fischell, as shown below in the *annotated* version of FIG. 9 included in the Office Action:

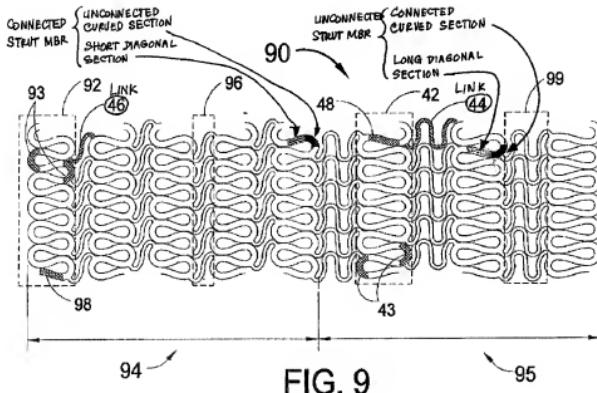


FIG. 9

However, the annotated labels added by the Examiner are at odds with the written description and the figures of the '775 patent, from which claim 38 substantially corresponds. FIG. 1 of the '775

patent is presented immediately below:

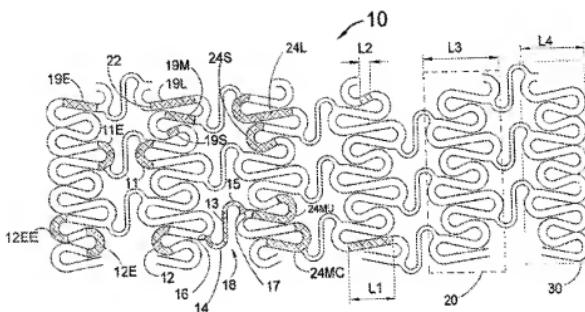


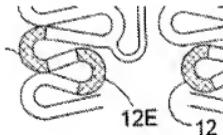
FIG. 1

The '775 patent states, "For the stent 10, the connected curved sections 11 and 11E and the unconnected curved sections 12 and 12E are shown in crosshatch in FIG. 1" (col. 4, lines 19–21).

Upon comparing *annotated* FIG. 9 of Fischell with FIG. 1 of the '775 patent, it is clear that the Examiner has taken a distinct—and unsupported—interpretation of the claim terms in claim 38. "When interpretation is required of a claim that is copied for interference purposes, the copied claim is viewed in the context of the patent from which it was copied." *In re Spina*, 975 F.2d 854, 858, 24 USPQ2d 1142, 1145 (Fed. Cir. 1992), citing *DeGeorge v. Bernier*, 768 F.2d 1318, 1322, 226 USPQ 758, 761 (Fed.Cir. 1985) (if claim language is ambiguous "resort must be had to the specification of the patent from which the copied claim came"). "A claim is not interpreted one way in light of the specification in which it originally was granted, and another way in light of the specification into which it is copied as a proposed interference count." *In re Spina*, 24 USPQ2d at 1145.

Using the meanings of *unconnected curved sections* and *connected curved*

sections as those terms are used in the '775 patent, it is clear that the term "unconnected curved section" means the *entire* curved end of a curved end which is not engaged to a connecting link, as shown below at 12 and 12E of FIG. 1 of the '775 patent,



and not an arbitrary region of the curved end, such as is asserted by the Office. Likewise, it is clear that the term "connected curved section" means the *entire* curved end of a curved end which is engaged to a connecting link, as shown below at 11 and 11E of FIG. 1 of the '775 patent:



Based on these term meanings, annotated FIG. 9 of Fischell does not teach or suggest at least the following limitation of claim 38: "each interior set of strut members also including at least one unconnected strut member consisting of a short diagonal section having a longitudinal length fixedly joined to an unconnected curved section." FIG. 9 of Fischell does not teach the above-quoted limitation of claim 38 because, unlike claim 38, *every curved section* of each interior set of strut members of the stent shown in FIG. 9 is *connected*. There are no unconnected curved sections in an interior set of strut members. As such, Fischell does not anticipate claim 38.

Therefore, because the Applicants have presented claim 38 in substantially the same form as at least one claim in the '775 patent in order to provoke an interference, and because the '775 patent describes the claim terms, the Examiner must adopt the definitions,

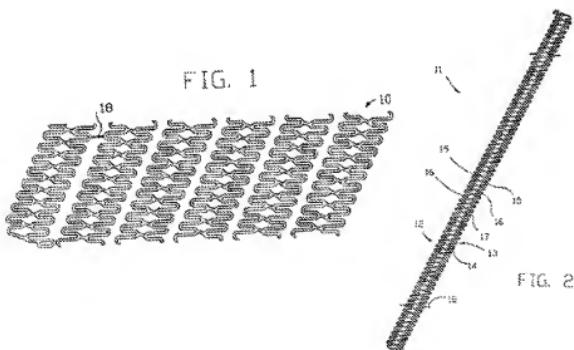
meanings, and/or usages of the terms in claim 38 *as those terms are used in the '775 patent.*

Claims 42 – 43 and 45 incorporate all the limitations of claim 38 and add additional limitations, making them patentable as well over Fischell. As such, claims 38, 42 – 43, and 45 are not anticipated. Applicants respectfully traverse the rejection and request that it be withdrawn.

II. Rejection Of Claims 38 And 39 Under 35 U.S.C. § 102(E) By Kanesaka

Regarding Claim 38 and 39

Kanesaka fails to teach or suggest all the elements of claim 38. Specifically, Kanesaka fails to teach or suggest at least the limitation of “a multiplicity of interior circumferential sets of strut members,” as recited in claim 38. FIGs. 1 and 2 of Kanesaka are reproduced immediately below:



Kanesaka states, “The stent 10 is formed of a diagonally arranged strip 11 as shown in FIG. 2, which is wound spirally in a cylindrical shape.” (Emphasis added)(col. 3, lines 50 – 52). And,

“The strip 11 includes two tortuous members 12, 13 connected by connecting members or joint struts 14.” (col. 3, lines 52– 54). And, “each tortuous member extends continuously and diagonally in a waving form.” (col. 3, lines 57– 58).

Based on the above-quoted language from Kanesaka, there is no “multiplicity of interior circumferential sets of strut members,” as recited in claim 38, because there is only a single set of strut members rather than a multiplicity of sets of strut members. There is only a single set of strut members in Kanesaka because the stent 10 is made from a single strip 11 made up of two tortuous members 12, 13 which is wound to form a cylindrical shape. As such, Kanesaka does not teach or suggest all the elements of claim 38.

Claim 39 incorporates all the limitations of claim 38 and adds additional limitations making it patentable as well over Kanesaka. As such, claims 38 and 39 are not anticipated by Kanesaka. Applicants traverse the rejection and request its removal.

III. Rejection Of Claim 46 Under 35 U.S.C. § 103(A) As Being Unpatentable Over Fischell In View Of Anderson

The Office rejected claim 46 under 35 U.S.C. § 103, alleging the same to be unpatentable over Fischell in view of Anderson.

The purported combination of Fischell and Anderson fails to teach or suggest all the limitations of claim 46. As argued above, Fischell fails to teach or suggest all the elements of claim 38, from which claim 46 depends. The addition of any alleged disclosure in Anderson of tantalum, as in claim 46, does nothing to remedy the deficiencies of Fischell as set forth above. As such, claim 46 is non-obvious. Applicants request that the rejection be withdrawn.

Conclusion

For at least the reasons discussed above, the subject matter in claims 38 – 39, 42 – 43, and 45 – 46 are patentably distinct over the cited art. Consequently, reversal of the rejections is respectfully requested.

Respectfully submitted,

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(viii) Claims Appendix

38. A stent in the form of a thin-walled, cylindrical tube with a longitudinal axis, the stent comprising:

a multiplicity of interior circumferential sets of strut members and one end circumferential set of strut members at each of the two longitudinal ends of the stent;

each interior circumferential set of strut members including at least one connected strut member consisting of a long diagonal section having a longitudinal length fixedly attached to a connected curved section, each connected curved section being joined by means of a longitudinal connecting link to one connected curved section of an adjacent circumferential set of strut members and all connecting links that connect adjacent circumferential sets of strut members are connected at a connected curved section, each interior set of strut members also including at least one unconnected strut member consisting of a short diagonal section having a longitudinal length fixedly joined to an unconnected curved section.

39. The stent of claim 38 wherein the longitudinal connecting link is straight.

42. The stent of claim 38 wherein there are three longitudinal connecting links that join each adjacent pair of circumferential sets of strut members.

43. The stent of claim 38 wherein there are five longitudinal connecting links that join each adjacent pair of circumferential sets of strut members.

45. The stent of claim 38 wherein the metal from which the stent is formed is stainless steel.

46. The stent of claim 38 wherein the metal from which the stent is formed is tantalum.

(ix) Evidence Appendix

None.

(x) Related Proceedings Appendix

None.